



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

PN

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,105	04/05/2001	Jan Michael Ouzounidis	14292.6	5012
7590	02/01/2006			EXAMINER
DANA L. TANGREN WORKMAN, NYDEGGER & SEELEY 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			PHAM, THOMAS K	
			ART UNIT	PAPER NUMBER
			2121	
			DATE MAILED: 02/01/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/827,105	OUZOUNIDIS ET AL.
	Examiner	Art Unit
	Thomas K. Pham	2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8-19,21-25,28,29 and 31 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,8-19,21-25,28,29 and 31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 April 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Response to Amendment

1. This action is in response to request for re-consideration filed on 11/22/2005.
2. Applicants' arguments have been considered but they are not persuasive.

Quotations of U.S. Code Title 35

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

7. Claims 1-4, 8-10, 12-17, 21-23, 25, 28-29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,928,325 ("Shaughnessy") in view of U.S. Patent No. 6,654,789 ("Bliss").

Regarding claim 1

Shaughnessy teaches a method for enabling the sending of messages to a recipient via any of a number of messaging systems of different types, the method comprising:

- storing address for said recipient (col. 4 line 66 to col. 5 line 6, "Upon receipt of the message ... of known database users");
- receiving recipient availability information from said messaging systems (col. 5 lines 7-16, "The central agent 15 ... in a known manner");
- interpreting said recipient availability information so as to determine in which of said messaging systems said recipient is currently available (col. 5 lines 17-20, "Once all the networks ... to send a message transmit"), wherein said recipient is considered to be available in at least said messaging system associated with a preferred address (col. 5 lines 10-14, "The central agent 15 then polls ... the incoming message right now");
- receiving an originator input including an identification of said recipient (col. 5 lines 10-14, "The central agent 15 then polls ... the incoming message right now"), wherein said originator input further includes a message (col. 4 lines 59-63, "When a message sourced ... by the receiving network(s)");
- identifying at least the messaging system associated with the preferred address (col. 5 lines 42-59, "Because the format type ... a low resolution graphics terminal"); and

- sending said message to said recipient via at least said messaging system associated with said preferred address (col. 5 lines 30-37, “When the device(s) to send ... on the chosen network(s)”).

It should be noted that since the user devices is selected based on the user-device select rules which may include look-up table and/or a decisional operation based (see col. 5 lines 17-22), the highest priority device (preferred device) among the devices inherently is a “preferred address” in which communication can be established.

Shaughnessy does not specifically teach the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient; and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient.

Bliss teaches the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient (see col. 2 lines 40-44, “As a first step 10 ... prefers others to contact him”); and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient (see col. 5 line 66 to col. 6 line 7, “A preferred address may only ... during the registration process”) for the purpose of searching and matching new and old email addresses of an entity to prevent email messages from delivering to a “dead” or unused address (see col. 1 lines 36-41 and 52-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the choosing and changing of a preferred address of Bliss with the delivery system of Shaughnessy because it would provide for the purpose of searching and

matching new and old email addresses of an entity to prevent email messages from delivering to a “dead” or unused address.

Regarding claim 14

Shaughnessy teaches a system for enabling the sending of messages to a recipient via any of a number of messaging systems of different types, comprising:

- first interface means connected to said messaging systems (col. 3 line 65 to col. 4 line 3, “Messages from the central agent 15 … of the cellular phone 34”);
- second interface means for receiving an originator input including an identification of said recipient (col. 5 lines 10-14, “The central agent 15 then polls … the incoming message right now”), said originator input further include a message (col. 4 lines 59-63, “When a message sourced … by the receiving network(s”));
- third interface means for receiving recipient availability information from said messaging systems (col. 5 lines 7-16, “The central agent 15 … in a known manner”);
- memory means for storing address for said recipient (col. 4 line 66 to col. 5 line 6, “Upon receipt of the message … of known database users”) at least on address being selectively identified by said recipient as a preferred address for communication with said recipient (col. 5 lines 10-14, “The central agent 15 then polls … the incoming message right now”);
- first processing means for identifying at least the messaging system associated to the preferred address (col. 5 lines 42-59, “Because the format type … a low resolution graphics terminal”); and

Art Unit: 2121

- second processing means for interpreting said recipient availability information so as to determine in which of said messaging systems said recipient is currently available (col. 5 lines 17-20, "Once all the networks ... to send a message transmit"), wherein said recipient is considered to be available in at least said messaging system associated with said preferred address (col. 5 lines 10-14, "The central agent 15 then polls ... the incoming message right now");
- wherein said first processing means are operatively connectively connected to said second processing means and said first interface means are arranged to send said message to said recipient via at least said messaging system associated with said preferred address (col. 5 lines 30-37, "When the device(s) to send ... on the chosen network(s)").

It should be noted that since the user devices is selected based on the user-device select rules which may include look-up table and/or a decisional operation based (see col. 5 lines 17-22), the highest priority device (preferred device) among the devices inherently is a "preferred address" in which communication can be established.

Shaughnessy does not teach wherein the system is configured such that said recipient can initially choose at least one of the stored addresses to be the preferred address and can subsequently change the preferred address by choosing a different at least one of the stored addresses to be a new preferred address.

However, Bliss teaches the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient (see col. 2 lines 40-44, "As a first step 10 ... prefers others to contact him"); and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient (see col. 5 line

66 to col. 6 line 7, “A preferred address may only ... during the registration process”) for the purpose of searching and matching new and old email addresses of an entity to prevent email messages from delivering to a “dead” or unused address (see col. 1 lines 36-41 and 52-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the choosing and changing of a preferred address of Bliss with the delivery system of Shaughnessy because it would provide for the purpose of searching and matching new and old email addresses of an entity to prevent email messages from delivering to a “dead” or unused address.

Regarding claim 29

Shaughnessy teaches a computer readable medium having computer-executable instructions for performing the steps of:

- storing address for said recipient (col. 4 line 66 to col. 5 line 6, “Upon receipt of the message ... of known database users”);
- receiving recipient availability information from said messaging systems (col. 5 lines 7-16, “The central agent 15 ... in a known manner”);
- interpreting said recipient availability information so as to determine in which of said messaging systems said recipient is currently available (col. 5 lines 17-20, “Once all the networks ... to send a message transmit”), wherein said recipient is considered to be available in at least said messaging system associated with a preferred address (col. 5 lines 10-14, “The central agent 15 then polls ... the incoming message right now”);
- receiving an originator input including an identification of said recipient (col. 5 lines 10-14, “The central agent 15 then polls ... the incoming message right now”), wherein said

originator input further includes a message (col. 4 lines 59-63, “When a message sourced ... by the receiving network(s”);

- identifying at least the messaging system associated with the preferred address (col. 5 lines 42-59, “Because the format type ... a low resolution graphics terminal”); and
- sending said message to said recipient via at least said messaging system associated with said preferred address (col. 5 lines 30-37, “When the device(s) to send ... on the chosen network(s”).

It should be noted that since the user devices is selected based on the user-device select rules which may include look-up table and/or a decisional operation based (see col. 5 lines 17-22), the highest priority device (preferred device) among the devices inherently is a “preferred address” in which communication can be established.

Shaughnessy does not specifically teach the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient; and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient.

Bliss teaches the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient (see col. 2 lines 40-44, “As a first step 10 ... prefers others to contact him”); and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient (see col. 5 line 66 to col. 6 line 7, “A preferred address may only ... during the registration process”) for the purpose of searching and matching new and old email addresses of an entity to prevent email messages from delivering to a “dead” or unused address (see col. 1 lines 36-41 and 52-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the choosing and changing of a preferred address of Bliss with the delivery system of Shaughnessy because it would provide for the purpose of searching and matching new and old email addresses of an entity to prevent email messages from delivering to a “dead” or unused address.

Regarding claims 2 and 15

Shaughnessy teaches one of said messaging system is a cellular mobile system and said recipient availability information includes an indication of whether a mobile unit of said recipient is available or not (col. 4 lines 3-14, “The central controller switch 31 ... by the central controller switch 31”).

Regarding claims 3 and 16

Shaughnessy teaches indication of whether said mobile unit of said recipient is available or not is an indication of whether said mobile unit of said recipient is attached to said cellular mobile system or not, further comprising: determining that said mobile unit of said recipient is available if said mobile unit of said recipient is attached to said cellular mobile system, and determining that said mobile unit of said recipient is not available otherwise (col. 4 lines 46-58, “The central agent 15 ... to the graphics terminal 44”).

Regarding claims 4 and 17

Shaughnessy teaches indication of whether said mobile unit of said recipient is attached to said cellular mobile system or not is received from a Home Location Register in said cellular mobile system (col. 3 line 65 to col. 4 line 7, “Messages from the central ... of an incoming message”).

Regarding claims 8, 21 and 31

Bliss teaches choosing a second address among said stored addresses, which second address is associated with a messaging system in which said recipient is currently available (col. 4 lines 63-66, “if the registrant has … e-mail over the system”); and sending said message to said recipient via the messaging system associated with said second address (col. 4 lines 66-67).

Regarding claims 9 and 22

Shaughnessy teaches originator input is received as a voice input, further comprising converting said voice input to text (col. 7 lines 19-27, “although the message … into one system 10”).

Regarding claims 10 and 23

Shaughnessy teaches further comprising: determining the type of message, text or voice, used in the messaging system associated with said second address (col. 5 lines 30-59, “When the device(s) to … resolution graphics terminal”); and sending said message as said determined type of message to said recipient via the messaging system associated with said second address (col. 5 lines 64-67, “After the transformation step is … to the appropriate chosen networks”).

Regarding claims 12 and 25

Shaughnessy teaches the messaging system associated with said second address is an e-mail system, said second address is an e-mail address of said recipient, and the message is sent as an e-mail via said e-mail system (col. 4 lines 63-66, “if the registrant has … e-mail over the system”).

Regarding claims 13 and 28

Shaughnessy teaches receiving a reply message from said recipient as said determined type of message via the messaging system associated with said second address (col. 6 lines 18-24, “Once

Art Unit: 2121

the availability of ... to the available devices"); converting said reply message to voice if said reply message is a text message (col. 6 lines 25-39, "If the email message ... for this purpose").

8. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaughnessy in view of Bliss and further in view of U.S. Patent No. 5,901,359 ("Malmstrom").

Regarding claims 5 and 18

Shaughnessy and Bliss teach enabling the sending of messages to a recipient via any of a number of messaging systems of different types but do not teach indication of whether said mobile unit of said recipient is attached to said cellular mobile system or not is received from a Visitor Location Register in said cellular mobile system.

However, Malmstrom teaches indication of whether the mobile unit of the recipient is attached to the cellular mobile system or not is received from a Visitor Location Register in said cellular mobile system (col. 3 lines 14-34, "The system includes a Wireline ... telephone number destination") for the purpose of routing single-number calls to the appropriate wireless network based upon the current location of the wireless recipient (see col. 2 lines 50-54).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the location indication of Malmstrom with the systems of Shaughnessy and Bliss because it would provide for the purpose of routing single-number calls to the appropriate wireless network based upon the current location of the wireless recipient.

9. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaughnessy in view of Bliss and further in view of U.S. Patent No. 6,018,657 ("Kennedy").

Regarding claims 6 and 19

Shaughnessy and Bliss teach enabling the sending of messages to a recipient via any of a number of messaging systems of different types but do not teach sending a Short Message Service message to said mobile unit of said recipient via a Short Message Service Center in said cellular mobile system; determining that said mobile unit of said recipient is available if an acknowledgement is received from the Short Message Service Center within a time limit; and determining that said mobile unit of said recipient is not available otherwise.

However, Kennedy teaches determining the availability status of a mobile unit by sending short messages to the mobile unit for predetermine time interval (col. 10 line 62 to col. 11 line 7, “destination messaging unit 14 … could not be delivered”) for the purpose of obtaining the availability status of the mobile unit when the unit may have traveled outside of the coverage area, powered down or is otherwise unable to receive a message (see col. 10 lines 62-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the messaging system of Kennedy with the systems of Shaughnessy and Bliss because it would provide for the purpose of obtaining the availability status of the mobile unit when the unit may have traveled outside of the coverage area, powered down or is otherwise unable to receive a message.

10. Claims 11 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaughnessy in view of Bliss and further in view of U.S. Patent No. 5,915,222 (“Olsson”).

Regarding claims 11 and 24

Shaughnessy and Bliss teaches the messaging system associated with the second address is a cellular mobile system, the second address is a mobile phone number of a mobile unit of the

Art Unit: 2121

recipient (col. 3 line 65 to col. 3) but do not teach the message is sent as a Short Message Service message via said cellular mobile system.

However, Olsson teaches transporting short message service messages via the cellular mobile system (see col. 2 lines 23-39) for the purpose of communicating unstructured data within a mobile telecommunication network (see col. 2 lines 18-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the Short Message Service of Olsson with the systems of Shaughnessy and Bliss because it would provide for the purpose of communicating unstructured data within a mobile telecommunication network.

Response to Arguments

In the remark applicants argue that the cited reference fails to disclose:

I) “recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient; and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient” as to claims 1, 14 and 29.

In response to applicants’ arguments,

I) Prior art Bliss (USPN 6,654,789) teaches the recipient choosing at least one of the stored addresses as a preferred address for communication with the recipient (see col. 2 lines 40-44); and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient (see col. 5 line 66 to col. 6 line 7).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation of combining the choosing of a preferred address in Bliss and the email delivery system of Shaughnessy is for searching and matching new and old email addresses of an entity to prevent email messages from delivering to a "dead" or unused address as described in column 1 lines 36-41 and 52-55

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2121

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-3689, Monday to Thursday from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (571) 272-3687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner



January 24, 2006



Anthony Knight
Supervisory Patent Examiner
Group 3600